

The opinion in support of the decision being entered
today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DEBORAH MARIE COCCARO,
JOHN MICHAEL PAULOVICH, and
EDWARD JOHN GIBLIN

Appeal No. 2007-0777
Application No. 09/955,894
Technology Center 3600

Decided: September 24, 2007

Before WILLIAM F. PATE, III, MURRIEL E. CRAWFORD, and HUBERT C.
LORIN, *Administrative Patent Judges*.

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DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from a decision of the Examiner rejecting claims 1-13.
35 U.S.C. § 134 (2002). We have jurisdiction under 35 U.S.C. § 6(b) (2002).

The claims are rejected as follows:

- Claims 1-6 and 8-13 under 35 U.S.C. § 103(a) as being unpatentable over Brown (US 6,578,763) in view of Maniwa (JP 11185164A);
- Claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Brown in view of Maniwa and in further view of Duvall (US 5,522,428); and,
- Claims 1-6 and 8-13 under 35 U.S.C. § 103(a) as being unpatentable over Brown in view of Rosenblum (US 6,766,218 B2).

We AFFIRM.

The rejection of claims 1-6 and 8-13 under 35 U.S.C. § 103(a) over Brown and Maniwa.

Appellants argue the claims as a group in the Brief¹. Accordingly, pursuant to the rules, the Board selects representative claim 1 to decide the appeal with respect to this rejection, and claims 2-6 and 8-13 will stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2006). Claim 1 reads as follows:

1. A method for purchasing a consumer product comprising the steps of:
 - (a) selling a consumer product in a package to a consumer at a point of purchase establishment;
 - (b) instructing the consumer to retain the package after the consumer product has been consumed; and

¹ Our decision will make reference to Appellants' Appeal Brief ("Br.," filed Aug. 8, 2005) and the Examiner's Answer ("Answer," mailed Oct. 21, 2005).

(c) providing a means for the consumer to have the package refilled with consumer product wherein the product is sold at a sale price that includes a predetermined number refills.

A. Issue

Appellants contend that the cited references do not show a “product is sold at a sales price that includes a predetermined number of refills and the formula/method described in claim 11².” Br. 7 (See also Br. 8).

The issue is whether Appellant has shown error in the rejection of the claims on the ground that the limitation that “the product is sold at a sale price that includes a predetermined number refills” (claim 1) and formula of claim 11 are not shown in the cited references.

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11. The method for purchasing a consumer product according to claim 1 wherein the method satisfies the formula $P_O < P_T + (P_R)N'$

where $P_O = P_T + (P_R)N$

P_O = original purchase price of a consumer product;

P_T = typical purchase price of a consumer product;

P_R = refill price;

N = a defined number of refills;

N' = a defined number of purchases; and

$N = N'$

and further wherein less environmental waste is generated and the consumer pays less money for the consumer product.

B. Findings of Fact

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Zero is a number.
2. The claims do not limit the method so as to require the package to be refilled.
3. Claim 1 calls for the product to be sold at a sale price that includes a predetermined number refills. The claim does not define the phrase “predetermined number” and the Specification does not attribute a specific number to the phrase. Accordingly, the phrase is given the plain meaning of the terms as it would be understood by one of ordinary skill in the art. The plain meaning of the phrase is that it covers any number of refills and, because zero is a number, that would including zero refills. Accordingly, the broadest reasonable construction of claim 1 in light of the Specification as it would be interpreted by one of ordinary skill in the art is that the claim encompasses the product being sold at a sale price that includes no refills.
3. Brown teaches selling a package with a product at a sale price and that the package can be refilled with the product.
4. Brown teaches selling a package with a product at a sale price and that the customer is given a coupon upon purchasing the packaged product which can then be used to purchase a refill of the product at a reduced price.

5. Appellants argue that Brown teaches that the consumer pays a vendor at each and every refilling.

In contrast, and again, the '763 reference [i.e., Brown] merely discloses a refillable bottle that is refilled in a machine with readable indicia on a container whereby the machine dispenses a discount coupon so that the consumer can use the coupon to pay the vendor at each and every refilling. Again, the present invention, as now defined in independent claim 1, is directed to a method whereby the consumer only has to pay the vendor a single time and the single sale price includes a predetermined number of refills. Thus, the present invention is significantly more efficient and consumer friendly than the process described in the '763 reference which merely shows a method for vending a specific liquid consumer product whereby the consumer has to pay a vendor at every refill.

Br. 8-9.

6. Brown discloses selling the original package with the product at a sale price that does not include a predetermined number of refills, i.e., the number of refills included in the sale price is zero.

7. The formula set forth in claim 11 (see footnote 2) puts the original purchase price for a product to be sold with a predetermined number of refills at less than the total of the typical purchase prices for the same number of products.³

8. It is well known in the art to price refills less than the original product.

9. It is well known in the art to sell a product with a predetermined number of refills.

³ Since $P_0 = P_T + (P_R)N$ and $P_0 < P_T + (P_T)N$, then $P_T + (P_R)N < P_T + (P_T)N$.

C. Principles of Law

Claim construction

1. “The Patent and Trademark Office (“PTO”) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’ *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 [70 USPQ2d 1827, 1830] (Fed. Cir. 2004).” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005).
2. “The problem is to interpret claims ‘in view of the specification’ without unnecessarily importing limitations from the specification into the claims.” *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003).

Obviousness

3. “Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459,

467 (1966). *See also KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 18, 148 USPQ at 467.

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious.

In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S.Ct. at 1739, 82 USPQ2d at 1395 (citing *Graham*, 383 U.S. at 12, 148 USPQ at 464 (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740, 82 USPQ2d at 1396. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

D. Analysis

Appellants argue that the cited references do not show the claim limitation that the “product is sold at a sales price that includes a predetermined number of refills.” We are not persuaded by this argument.

The broadest reasonable construction of claim 1 in light of the Specification as it would be interpreted by one of ordinary skill in the art is that the claim encompasses the product being sold at a sale price that includes no refills. FF 3. Brown discloses selling the original package with the product at a sale price that includes no refills. FF 6. Accordingly, Brown discloses the claim limitation that the “product is sold at a sales price that includes a predetermined number of refills.”

Furthermore, it is well known in the art to sell an original product along with a predetermined number of subsequent refills (e.g., in many establishments are known to sell coffee packaged in cups with lids to customers with a number of free refills). FF 9. Brown discloses selling refills separately from the original product. But given the knowledge that a product can be sold coupled with a predetermined number of subsequent refills, as a matter of efficiency, it would have been obvious to one of ordinary skill in the art to combine Brown’s separate sales of the original product and subsequent refills and thus sell the original “product at a price that

includes a predetermined number of refills.” “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1739, 82 USPQ2d 1385, 1395 (2007).

Regarding claim 11 and the formula set forth therein, it describes putting the original purchase price for a product to be sold with a predetermined number of refills at less than the total of the typical purchase prices for the same number of products. FF 7. Given that refills are normally priced below the original product (FF 8), it would have been obvious to one of ordinary skill in the art to combine Brown’s separate sales of the original product and subsequent refills, and thus arrive at the claimed method of selling the original “product at a price that includes a predetermined number of refills,” and to price that combination below the total price for the same number of original products.

Appellants also argue that Brown does not suggest “the product being sold can be in [a] form other than a liquid, and there is no teaching whatsoever in [Brown] that even remotely suggests that the product can be in the form of a concentrate.” Br. 9. The argument is unpersuasive because Brown in fact discloses concentrates at col., 3, l. 12.

Accordingly, we affirm the rejection of the claims over the cited references.

However, our reasoning in concluding that the claimed method would have been obvious to one of ordinary skill in the art departs somewhat from that of the Examiner. Accordingly, though we affirm the rejection, we denominate the rejection as a new ground under 37 C.F.R. §41.50(b).

E. Conclusion of Law

On the record before us, Appellant has failed to show that the Examiner erred in rejecting the claims over the prior art.

The rejection of claim 7 under 35 U.S.C. § 103(a) over Brown, Maniwa, and Duvall.

A. Issue

The issue is whether Appellant has shown error in the rejection of claim 7.

B. Findings of Fact

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Claim 7 reads as follows:

7. The method for purchasing a consumer product according to claim 1 wherein the package is suitable to be refilled a predetermined number of times, the predetermined number of times being less than a number of times that causes stress fractures in the package.

2. Packages suitable to be refilled a predetermined number of times, the predetermined number of times being less than a number of times that causes stress fractures in the package, are well known.

C. Principles of Law

We incorporate herein the principles of law listed supra.

D. Analysis

Appellants argue that the prior art does not show that “a consumer can make a single payment and have a container refilled a predetermined number of times, ensuring that the container will not break or stress fracture during the using and refilling period.” Br. 11. This argument is not persuasive because Brown discloses refilling a container any number of times. Since containers suitable to be refilled a predetermined number of times, the predetermined number of times being less than a number of times that causes stress fractures in the package, are well known, one of ordinary skill in the art reading Brown would foresee practicing Brown’s method so as to refill the container but not cause the container to break or stress fracture during the using and refilling period. It would have been obvious to one of ordinary skill in the art to combine Brown’s separate sales of the original product and subsequent refills, and thus arrive at the claimed method of selling the original “product at a price that includes a predetermined number of refills,” and to price that combination below the total price for the same number of original products, whereby the predetermined number of refills included in the sale price would not cause the container to break or stress fracture during the using and refilling period.

Accordingly, we affirm the rejection of the claims over the cited references.

However, our reasoning in concluding that the claimed method would have been obvious to one of ordinary skill in the art departs somewhat from that of the Examiner. Accordingly, though we affirm the rejection, we denominate the

rejection as a new ground under 37 C.F.R. §41.50(b).

E. Conclusion of Law

On the record before us, Appellant has failed to show that the Examiner erred in rejecting the claims over the prior art.

The rejection of claims 1-6 and 8-13 under 35 U.S.C. § 103(a) as being unpatentable over Brown and Rosenblum.

A. Issue

The issue is whether Appellants have shown error in the rejection of over Brown and Rosenblum.

B. Findings of Fact

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. We incorporate herein the facts listed in the Findings of Fact section with respect to the rejection of claims 1-6 and 8-13 under 35 U.S.C. § 103(a) over Brown and Maniwa above and add the following.
2. Rosenblum shows a product (i.e., a prescription) sold with a predetermined number of refills. See col. 9, ll. 34-35: “The number of refills permitted without the patient requiring a new prescription is chosen. . . .”

C. Principles of Law

We incorporate herein the principles of law listed supra.

D. Analysis

Appellants make the same arguments with respect to this rejection as were made against the rejection of claims 1-6 and 8-13 under 35 U.S.C. § 103(a) over Brown and Maniwa above. For the same reasons we used to affirm that rejection, we will affirm this rejection as well. We add, however, that Rosenblum confirms the earlier finding of fact (FF 9 in the Findings of Fact section with respect to the rejection of claims 1-6 and 8-13 under 35 U.S.C. § 103(a) over Brown and Maniwa) that it is well known in the art to sell an original product along with a predetermined number of subsequent refills. See FF 2. In view of the disclosure in Rosenblum that a product can be sold coupled with a predetermined number of subsequent refills, it would have been obvious to one of ordinary skill in the art to combine Brown's separate sales of the original product and subsequent refills and thus sell the original "product at a price that includes a predetermined number of refills." "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1739, 82 USPQ2d 1385, 1395 (2007).

Accordingly, we affirm the rejection of the claims over the cited references.

However, our reasoning in concluding that the claimed method would have been obvious to one of ordinary skill in the art departs somewhat from that of the Examiner. Accordingly, though we affirm the rejection, we denominate the

rejection as a new ground under 37 C.F.R. §41.50(b).

E. Conclusion of Law

On the record before us, Appellant has failed to show that the Examiner erred in rejecting the claims over the prior art.

DECISION

The rejection of claims 1-6 and 8-13 under 35 U.S.C. § 103(a) over Brown and Maniwa, or Brown and Rosenblum, and the rejection of claim 7 under 35 U.S.C. § 103(a) over Brown, Maniwa, and Duvall are affirmed but denominated as new grounds of rejection under 37 C.F.R. §41.50(b).

Regarding the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides “[a]ppellant may file a single request for rehearing within two months from the date of the original decision of the Board.”

In addition to affirming the examiner's rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should the appellant elect to prosecute further before the examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

AFFIRMED

NEW GROUND OF REJECTION UNDER 37 C.F.R. § 41.50(b)

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